



MAIL STOP AF
PATENT
1506-1002

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Peter ÅHNBLAD et al.

Conf. 3709

Application No. 10/069,595

Group 3763

Filed June 4, 2002

Examiner Mark K. Han

NASAL RINSER AND OUTLET PORTION THEREFOR

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

Applicant requests a pre-appeal brief review of the final rejection in the above-identified application. No amendments are being filed with this request.

A Notice of Appeal is filed herewith.

The review is requested for the reasons advanced on the attached sheets.

Respectfully submitted,

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REASONS IN SUPPORT OF REQUEST FOR REVIEW

A pre-appeal brief review is respectfully requested because the rejections of independent claim 1 and dependent claim 2 include at least a clear factual error, or in the alternative, a clear legal error, as explained below.

Applicant requests review of the final rejection of claim 1 as anticipated by WOLF 4,767,416 and of claim 2 as obvious over WOLF in view of BLACKMAN 2,485,184.

Claim 1

WOLF does not disclose each feature recited by claim 1 and therefore the anticipation rejection is a clear error since anticipation requires disclosure of each recited feature.

Claim 1 recites an outlet portion (1) for a nasal rinser.

WOLF discloses a spray nozzle for a syringe and not a outlet portion for a nasal rinser. Thus, this recited feature of the invention is not disclosed.

Claim 1 further recites (emphasis added) "an outlet end (2), a connection end (3) and a nozzle shaped channel (4) between the outlet and connection ends, **the nozzle shaped channel (4) having an internal hourglass shape** comprising a channel restriction section (5) and an expanded channel outlet section (6), wherein an inner diameter of the

expanded channel outlet section (6) is greater than an inner diameter of the channel restriction section (5)."

WOLF Figure 2 has been offered for these features. Figure 2 is an illustration of a hypodermic needle 21 attached to a luer fitting 11 of syringe 10 and spray nozzle 20 fit over and enclosing the needle.

Spray nozzle 20 comprises a conduit 25 which is tapered i) from a major diameter 26 at the end proximal the syringe ii) to a reduced diameter 27 adjacent the tip of the needle. See column 2, lines 37-46.

Channel 25 was offered as the recited nozzle shaped channel having an hourglass shape. However, channel 25, even if considered to be nozzle shaped channel, does not have the recited hourglass shape.

The other illustrated version of the WOLF spray nozzle is shown in Figure 1. The internal conduit 15 of this nozzle is illustrated as being cylindrical.

Thus, neither illustrated WOLF spray nozzle comprises a nozzle shaped channel having an hourglass shape.

Therefore, this recited feature of the invention is also not disclosed and the anticipation rejection is a clear error for this further reason.

Claim 2

As to dependent claim 2, there is recited "an enlarged circumference portion (12) at the outlet end (2)

for sealing at use between the outlet portion (1) and the users nostril."

BLACKMAN is offered as disclosing an enlarged outlet end. But this combination is improper and it is clear error to find that one of skill would modify the WOLF syringe to include an enlarged outlet end for sealing at use with a users nostril. There is no basis for concluding that syringes would have that structure or would be used in that manner.

In this situation, the present disclosure itself is effectively being used to render the claimed invention obvious. Such a hindsight approach is not permitted.

The Federal Circuit stated that "[m]ost, if not all, inventions are combinations and mostly of old elements." In re Rouffett, 47 USPQ 2d 1453, 1457 citing to Richdel, Inc. v. Sunspool Corp., 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention."

Thus, the Federal Circuit requires that in order to prevent the use of such hindsight, the Official Action must "show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of

the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (In re Rouffett at 1458). There is no suggestion that one of skill would be motivated to adapt the SYRINGE of WOLF to have "an enlarged circumference portion (12) at the outlet end (2) for sealing at use between the outlet portion (1) and the users nostril".

As stated by MPEP §706.02(j), to establish a prima facie case of obviousness the Official Action must first, consider the relevant teachings of the prior art, and after determining the differences between the pending claim and the prior art teachings, second, propose modifications of the prior art necessary to arrive at the claimed subject matter, explaining the motivation for combining the particular references and making the proposed modifications to those references. Thus, there must be viable motivation to modify the references. Such motivation does not exist with respect to WOLF.

In this regard, it is well established that the teaching or suggestion to make the claimed combination and the reasonable expectation of success therein must both be found in the prior art, and not be based on the present disclosure. In re Vaack, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further, the prior art references must either expressly or impliedly suggest the claimed invention or the Official Action must convincingly reason why one skill in

the art would have found the claimed invention obvious in light of the teachings of the references. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). In the present situation, there is no teaching or suggestion available to provide the requisite motivation, suggest the necessary modifications to modify WOLF as suggested. Thus, the obviousness rejection of claim 2 is a clear error.

Summary

Since WOLF does not disclose the recited features of claim 1 and the combination of WOLF and BLACKMAN as to claim 2 is improper, there is clear error as to both these rejections. In view of this, these rejections of record cannot be sustained and must be reversed; such is respectfully requested.